

**REMARKS**

Claims 1, 4, 13 and 14 have been amended. Claims 21-27 have been added. Applicant respectfully requests admission of claims 21-27. Applicant contends that the amendments and added claims contained herein are supported by the Specification as filed and thus do not constitute new matter. Claims 2-3, 5-8, and 16-20 have been canceled.

**Election/Restrictions**

The present application was subjected to a Restriction Requirement by Examiner Betelhem Shewareged in the Office Action mailed June 19, 2003. The Restriction Requirement indicated the following groups:

- I. Claims 1-16 drawn to print media.
- II. Claims 17-20 drawn to a method of transferring.

The Restriction Requirement further indicated the following patentably distinct species of Group I:

- A. Print media having pressure sensitive adhesive (claims 2-5 and 14).
- B. Print media having dry adhesive (claims 6, 15, and 16).
- C. Print media having a static force (claim 7).

The Restriction Requirement also indicated that claims 1 and 8-13 were generic. Applicant elected Group I, Species A, claims 2-5 and 14 along with generic claims 1 and 8-13 in the Response (Paper No. 5) filed on September 25, 2003.

Claims 6 and 16 and claims 17-20 have been canceled. Applicant contends that claim 13, as amended, is generic with respect to claims 14 and 15. Applicant further contends that added claims 21-26 comport with the subject matter of Group I, Species A and thereby elects claims 21-26 with traverse. Applicant contends that claim 21 is generic with respect to claims 22-27. Upon allowance of a generic claim, Applicant is entitled to consideration of claims to additional species which are written in dependent form or otherwise include all limitations of an allowed generic claim under 37 CFR 1.141. In particular, Applicant requests consideration of claim 15 upon allowance of generic claim 13 and claim 27 upon allowance of generic claim 21.

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Rejections Under 35 U.S.C. § 102

Claims 1-3 and 8-14 are rejected under 35 U.S.C. § 102 (e) as being anticipated by Mahn, Jr. (U.S. Patent 6,224,958). Applicant respectively traverses the rejection of claims 1-3 and 8-14.

Claim 1, as currently amended, includes the limitations of claims 2 and 5. Therefore, claim 1 is equivalent to claim 5 rewritten in independent form and including all of the limitations of the base claim (claim 1) and any intervening claims (claim 2). The Examiner indicated in paragraph 9 of the Office Action that claim 5 would be allowable if rewritten in independent form and including all of the limitations of the base claim (claim 1) and any intervening claims (claim 2). Therefore, applicant contends that claim 1, as currently amended, should be allowable.

Claims 2-3 and 8 are canceled thus overcoming the rejection thereof.

Claims 9-12 depend directly or indirectly from claim 1 and therefore include patentable limitations of claim 1. Therefore, claims 9-12 should be allowed.

Claim 13, as currently amended, includes in part a rubber sheet that is adapted to release from an adhesive layer. Applicant carefully reviewed Mahn, Jr. and found no indication of a rubber sheet that is adapted to release from an adhesive layer, as in claim 13. Therefore, Mahn, Jr. does not include each and every element of claim 13, and claim 13 should be allowed.

Claim 14 depends directly from claim 13 and therefore includes patentable limitations of claim 13. Therefore, claim 14 should be allowed.

Rejections Under 35 U.S.C. § 103

Claim 4 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Mahn, Jr. (U.S. Patent 6,224,958), as applied to claims 1-3 and 8-14, above and in further view of Magill et al. (U.S. Patent 5,813,772) and Onishi (U.S. Patent 5,955,167). Applicant respectfully traverses this rejection.

Claim 1 is patentably distinct from Mahn, Jr. Moreover, Magill et al. in combination with Mahn, Jr. and Onishi in combination with Mahn, Jr., fail to overcome

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the deficiencies of Mahn, Jr. with respect to claim 1. Therefore, claim 1 is allowable over Mahn, Jr. in view of Magill et al. and Onishi. Claim 4 depends directly from claim 1 and thus includes patentable limitations of claim 1. Therefore, claim 4 is allowable over Mahn, Jr. in view of Magill et al. and Onishi.

*Allowable Subject Matter*

Claim 5 was objected to as being dependent upon a rejected base claim, but allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims. Applicant thanks the Examiner for this indication. In view of its incorporation into claim 1, claim 5 is canceled, thereby overcoming the objection thereto.

*Added Claims*

Claim 21 is directed to a print media for use in an imaging device. The print media includes a first sheet having a printable surface and a second surface opposite the printable surface. The first sheet is rubber. A second sheet has a first surface adhered to the second surface of the first sheet by an adhesive interposed between the first surface of the second sheet and the second surface of the first sheet. The first sheet is adapted to release from the adhesive. There is no indication of this in Mahn, Jr. or in Magill et al. in combination with Mahn, Jr. and Onishi in combination with Mahn, Jr. Therefore, neither Mahn, Jr. nor Magill et al. in combination with Mahn, Jr. and Onishi in combination with Mahn, Jr. include each and every element of claim 21, and claim 21 should be allowed.

Claims 22-26 depend directly from claim 21 and thus include patentable limitations of claim 21. Therefore, claims 21-28 should be allowed.

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**CONCLUSION**

In view of the above, Applicant respectfully submits that the claims are in condition for allowance and requests reconsideration of the application and allowance of the claims. If the Examiner has any questions regarding this application, please contact the under-signed at (612) 312-2208.

Respectfully submitted,

Date: 03-03-2004

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